

IN THE
United States
Circuit Court of Appeals
For the Ninth Circuit.

WARREN BROTHERS COMPANY,
Appellant,

vs.

C. M. THOMPSON, O. M. THOMPSON, E. O.
THOMPSON, Copartners Doing Business
Under the Firm Name and Style of THOMP-
SON BROTHERS; H. E. VOGEL and J. B.
HILL,

Appellees.

SUPPLEMENTAL BRIEF FOR APPELLEES.

GEORGE R. LOVEJOY,
District Attorney of the County of Fresno.

RAY C. WAKEFIELD,
Special Counsel for the County of Fresno.

FREDERICK S. LYON and
LEONARD S. LYON,
Special Patent Counsel, Solicitors for Defendants-Appellees.

No. 4036.

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WARREN BROTHERS COMPANY,
Plaintiff-Appellant,
vs.

C. M. THOMPSON et al.,
Defendants-Appellees.

Supplemental Brief for Appellees.

Pursuant to permission granted by the Court, appellees present this brief in answer to the reply brief for appellant. A reading of the latter in connection with our opening brief will show that numerous main points upon which our defense is based remain entirely unanswered, and not even mentioned. The inference is, of course, that appellants have no answer to offer to those points and realize that to mention them would only emphasize the weakness of appellant's case. We will limit our response to the points mentioned in appellant's reply brief.

In our brief we state that the primary issue here is the construction to be given the Wallace patent in suit (p. 11) and that appellant is proceeding upon a misstatement and misconstruction thereof (p. 8). We set forth the true construction of the Wallace patent (pp. 8-11) and demonstrate the same by the specification and claims of the Wallace patent (pp. 28-37) and the meaning attached thereto by Wallace before the Patent Office (pp. 37-52). Appellant does not attempt to reconcile the terms of the Wallace patent or the contents of the file-wrapper with its misconstruction of the patent.

In its reply brief, under the unwarranted title, "The Admitted Outstanding Facts," appellant first states that the necessity for providing the Warren pavement with "repeated flush coatings" presented "a very real problem in the paving art" and that this is the problem solved in the patent in suit (Appellant's Reply Brief, p. 4). Appellant makes no attempt to show that the Wallace patent states or recognizes this problem. To the contrary, the Wallace patent states that its "problem" or object is to provide a pavement

"adapted to be expeditiously laid at small cost of skilled-direction, apparatus, labor and material, and one having a surface-coating or upper course that is rendered impermeable to the elements without the use of so much comminuted or other fine material that the surface-coating mixture is 'mushy' in character, and also having a lower course possessed of rigidity, so that the pavement as a whole is well

calculated to withstand the conditions and the usage to which composite pavements are ordinarily subjected.” (P. 1, lines 12-23).

Appellant has concocted a problem for the Wallace patent, which is unmentioned therein. Indeed, no such problem existed in the paving art. The use of a “flush coat” is merely optional under the Warren patents, and the alternative of employing a thin layer of fine bituminous mixture is described therein. Warren Patent 675,430 states that:

“The surface of the roadway may -or may not be covered with a thin coating of bituminous mixture of sand, gravel, screenings, or gravel mixed with coal-tar or other equivalent material.

“Referring again to the drawings, C represents the layer of prepared ingredients, and E, Fig. 3, the thin finishing coating above referred to.” (Record, p. 499-f, p. 2, lines 31-39 of patent.)

Warren Patent 727,505 states that the pavement may be covered with a “thin surfacing of clear asphalt cement *or* an asphalt or bituminous composition of any desired nature.” (R. 499-d, p. 1, lines 94-96). The uncontradicted testimony of Mr. Leyden as to appellant’s practice with the Warren pavement is:

“I laid this pavement for years under contracts authorized by plaintiff Warren Brothers Company and under inspection of representatives of said company. Until shortly prior

to the expiration of said patent No. 727,505, to my knowledge, plaintiff Warren Brothers through its representatives, consistently asserted that the method of that patent was the most practical and discouraged the use of a finishing coat consisting of previously mixed finely divided aggregate and bitumen. It was only shortly before that patent was about to expire, to my knowledge, that plaintiff Warren Brothers Company, attempted to introduce or laud the method or type of construction embodied in said 'Type B' specifications." (R. 149.)

The Wallace patent was issued in May, 1910, and was available to appellant for the ten years intervening before the expiration of Warren Patent 727,505. Yet five years later (1915) plaintiff laid or licensed the laying of approximately twenty times as much Warren pavement as of the alleged patented Wallace Type (R. 485). In the ten-year period between the grant of the Wallace patent and the expiration of the Warren patent, more than three times as much Warren "flush-coat" pavement was laid than of the alleged Wallace type (R. 485). Obviously, if there had been any "very real problem" or objection to the Warren pavement, as represented by appellant, the laying of Warren pavement in large quantity would not have so continued in disregard of the alleged Wallace invention. That "problem" never existed in fact, and has no place in the construction of the Wallace patent.

The reply brief for appellant charges that appellees are urging a construction of the Wallace patent before this Court contrary to the position taken by appellees before the trial court. For the purpose of comparing pavement in which the under-layer had no individual rolling with a pavement in which the under-layer had an individual rolling, Mr. Jensen took Type B and Type A, and for the purposes of such comparison assumed that Type B is the pavement of the patent in suit. In making such assumption in his affidavit, Mr. Jensen disclaimed any responsibility for its correctness, and placed all responsibility upon appellant, as follows: "In Exhibit '5' to the Bill of Complaint (beginning at page 16A) appears specifications for 'Asphaltic Wearing Surface, Type B.' These specifications are prepared by me from the standard specifications submitted by plaintiff, Warren Brothers Company, *purporting to be the pavement of the patent in suit.*" (R. 158.) As stated in our opening brief, Mr. Jensen was not in a position to legally construe the patent in suit, and his assumption is not controlling or binding upon this Court (p. 133). Appellees specifically pointed out to the trial court and urged that Type B is not the pavement patented in the Wallace patent. In their printed brief to the trial court, appellees stated: "Furthermore, Type B specifications cannot be substituted for the Wallace patent for purposes of comparison because the Type B specifications depart from the basis of the Wallace patent by employing the old Warren method of selecting and proportioning the aggregate for the

intermediate course and thereby fill the voids in the intermediate course both at the top and at the bottom" (p. 64). Before the trial court, appellees urged for the Wallace patent precisely the same interpretation and construction as urged by appellees before this Court. For example, in their printed brief to the trial court, appellees said:

"The Wallace invention was designed to obtain the essential advantages of the Warren mixture without having to carefully select and mechanically proportion the grades of mineral aggregate. Wallace conceived of taking mineral aggregate just as it comes from a rock crusher without separating the grades or selecting and proportioning the same, mixing with the crusher run a proper amount of asphalt, and spreading the same without compression on the road foundation. Instead of following the Warren practice of selecting, proportioning and mixing with the mineral aggregate a proper amount of fine mixture at the mixing plant, Wallace conceived of introducing the fine mixture by merely spreading it over the uncompressed crusher run prepared as aforesaid. His theory was that if the pavement thereafter be given its initial and only compression that then the fine mixture would be driven down into the crusher run mixture. Wallace believed that this 'blending' as he describes it, of this fine mixture into the crusher run mixture would give at the top of the pavement a structure substantially as dense and free from voids

as was the Warren mixture. But he felt that his method was a distinct advantage over the Warren method because he eliminated any necessity for selecting and proportioning the grades of mineral aggregate. This would cheapen the cost of laying the pavement because it would eliminate the necessity of a technical expert to make the proper proportioning, would eliminate the necessity of the apparatus for screening, would cut down the labor employed in laying the pavement, and would be a saving in material because the fine mixture would only be used at the top of the pavement and would not be distributed throughout the mass as is the case in the previously mixed Warren mixture. Upon examination of the Wallace patent we find that he has clearly stated and patented the foregoing as his invention." (pp. 18-20.)

There is no justification whatever for the claim of appellant that appellees are taking before this Court a position in any wise different from appellees' position before the trial court.

Characteristic of its misconstruction of the Wallace patent, appellant misinterprets our argument that there is no infringement because appellees employ the Warren mixture for their intermediate layer in lieu of the crusher-run called for by the Wallace patent. In our opening brief we have carefully pointed out that in the mixture of Warren Patent 727,505 not only are the different grades or sizes of stone pieces mathematically proportioned,

but to this mosaic aggregate there is added a quantity of additional fine material or sand sufficient to fill the voids to the greatest possible repletion. The "crusher-run" which is to constitute the material for the mixture B of the Wallace patent not only distinguishes from the Warren mixture in that the sizes of stone pieces are unproportioned, but also in the fact that no sand is added to the crusher-run before the mixture B is spread upon the base of the pavement. In its reply brief, appellant argues that there may be sufficient sand or fine material in a crusher-run to fill the voids without the necessity of the addition of any sand (p. 21) and that the only distinction between a Warren mixture and a crusher-run is merely that in one the rock pieces are proportioned according to size, and not in the other (p. 24). This is erroneous in fact and is absolutely refuted by the specification and drawing of the Wallace patent. If the Court will look at the mixture B as it appears in the drawing of the Wallace patent it will observe that the "crusher-run" there illustrated is replete with voids which are not filled by sand or fine material. The object of the fine mixture C of the Wallace patent is to fill these voids in the upper portion of the mixture B, and, with this exception, such voids remain unfilled. As stated in the specification of the Wallace patent: "Inasmuch as the fine mixture in the thin or surface course C is used at the surface only instead of being distributed throughout the whole mass a comparatively small quantity of the fine mixture is required." (Wallace Patent,

. 2, lines 17-22). If appellant were correct that there is sufficient fine material in the crusher-run comprising mixture B to fill the voids throughout the whole mixture B, then the sentence last quoted from the specification of the Wallace patent has no basis in fact and Wallace was incorrect in there stating that one "advantageous characteristic" of his invention was that the fine material or sand is used only in the upper portion of the mixture B and not "distributed throughout the whole mass." The drawing of the Wallace patent demonstrates that the voids in a crusher-run will remain unfilled unless some additional sand or fine material be added to the crusher-run and appellant's position is irreconcilable with the drawing of its own patent.

If the Court will now compare the photographic illustration of the Warren mixture constituting appellant's Exhibit "D" (R. 132) or the photograph constituting appellees' Exhibit "G" appearing opposite p. 63 of our main brief and showing the Warren mixture as it appears in Type A, with the drawing of the Wallace patent, it will observe that in the Warren mixture the voids are filled to repletion by fine material uniformly throughout the mixture, whereas, in the Wallace pavement, the voids are unfilled except to the extent that the same are filled in the upper portion by the mixture C. Wallace relied upon this distinction before the Patent Office to obtain his patent; for example, in an amendment filed by him in the Patent Office on February 5, 1910, Wallace stated: "Applicant further wishes to emphasize the fact that while McDonald attempts

to fill the voids to repletion throughout the mass, he (applicant) does not attempt to fill the voids except in the upper portion of the mass, i. e., the upper part of the surface subjected to the abrasive action of the traffic * * * .” (R. 463). Wallace has thus made leaving unfilled the voids (in the lower portion of the mass) a controlling distinction in his proposed pavement, and yet it is a distinction which appellant has entirely ignored in its reply brief. Appellant has nowhere attempted to reconcile with its misinterpretation of the Wallace patent, the fact that the drawing of the Wallace patent shows the voids unfilled except to the extent that the same are filled in the upper portion only by the mixture C; the fact that the specification of the Wallace patent emphasizes the employment of only sufficient material to fill the voids at the top; and the fact that Wallace so distinguished his invention before the Patent Office. Indeed, appellant has ignored and attempted no reply whatsoever to the discussion beginning at p. 41 of our opening brief under the title, “Wallace Understood and Intended That the Claims as Finally Granted in His Patent Be Limited to a Single Layer in Which the Voids At the Top of the Mass Were Filled by Blending Thereinto the Fine Mixture C.”

Appellant refers to the case of Warren Bros. Co. vs. City of New York, 187 Fed. 831, as establishing that there is no difference between a “crusher-run” mixture and the Warren mixture (p. 23), but appellant fails to note that in that case the defendant did not merely employ a crusher-run to which no sand

had been added. It clearly appears from the reported decision that the defendant in fact added to the "crusher-run" the necessary sand to fill the voids therein. In fact, the text of the decision shows that to nine parts of crusher-run stone the defendant added three parts of sand and one of cement (187 Fed., at p. 834). The mixture employed by the defendant in that case was like the Warren mixture in that the necessary sand was added to fill the voids uniformly throughout the mass. Clearly, the case is no authority that there is no difference between a Warren mixture and a crusher-run to which no sand has been added. This case has also been cited by appellant in connection with its argument that a patent covering a pavement having "a blend" is infringed by any pavement having "a blend" irrespective of how that blend be obtained. It will be noted that the opinion was merely on a motion for a preliminary injunction, and that a primary ground for the grant of the injunction was the fact that the defendant withheld from the Court a specimen of its proposed pavement. We ask the Court to read the much later decision of the Circuit Court of Appeals for the Third Circuit, dealing with the same patent, in *Evans vs. Warren Bros.*, 240 Fed. 696, in which the Court said: "In the very nature of things, he could not have a monopoly of a physical characteristic, such as the quality of inherent stability"; and, "It would seem, therefore, that such graded ingredient was his disclosure and his only disclosure, and that a structure, even though it has less than 20 per cent

of voids which does not contain 'these ingredients,' was something that Warren neither discovered nor disclosed"; and, "If this claim is to be construed as a monopoly for any structure that contains less than 21 per cent of voids it is not a patentable, allowable claim, for it would be a claim for a mere physical fact"; and that the defendant's "Filbertine" did not infringe because "whatever voids Filbertine has is a void that is obtained by a *different method* than the graded material method of claim 9."

In an attempt to answer its own question of "What Was Wallace's Real Step Forward" (p. 6), appellant has pursued its search for a Wallace invention to a vanishing point. It is first conceded by appellant that "there was no novelty in a coarse-to-fine mixture, whether carefully graded or 'crusher run.' " (p. 6) Appellant further concedes that "Nor was there any novelty in a layer of fine mixture used as a surfacing. Such a mixture had even been laid in a thin layer on top of a thick layer of coarse mixture below." (p. 7.) Within its own misconstruction of the Wallace patent, appellant admits that the "sole novelty" of Wallace lay in a "blend" between the upper layer of fine material and an underlayer of coarse mixture (p. 7). Beginning at p. 115 of our opening brief, we point out that appellant's misconstruction of the Wallace patent had forced appellant to a point where the Wallace patent if so construed is void, because the same fails to describe an essential feature required to obtain such "blend," to wit: Wal-

lace's patent fails to state that the under layer must be hot at the time the upper layer is applied. Appreciating that our position is impregnable on this point, in its reply brief appellant is forced to the desperate position that anyone could have obtained the necessary blend without any invention, if such person had merely had the idea of wanting the blend. In other words, as said in the reply brief for appellant: "Given Wallace's idea of the blend, it was obvious that the lower coarse must be plastic when the surfacing was applied in order to obtain the blend, and the means of keeping it plastic were familiar to everyone. But the *idea of the blend* was not obvious." (p. 41.) Appellant concedes that it was perfectly obvious how to obtain a blend, and the only novelty now claimed for the Wallace invention by appellant is the idea of wanting a blend. In conceding that Wallace did not even invent how to obtain a blend, and that the only novel feature which Wallace had was the idea of wanting a blend, appellant has pursued the Wallace invention beyond the vanishing point. It is an elementary principle of patent law that a mere idea of wanting something is not patentable and that, given the want, it must require invention to fill the want, else there is no patentable invention. In simple language: it is not patentable to want to do something, and the invention must reside in discovering how to do it. Appellant admits that no invention is required to obtain the blend, if the same be desired. Wallace, therefore, made no patentable invention, and his patent is void, within the familiar and elementary

rule above stated. A case in point is the late decision of the Circuit Court of Appeals, for the Second Circuit in *Treat vs. Redtop Electric Co.*, 271 Fed. 307. In that case, the idea occurred to the patentee to devise an electric attachment plug which would fit either flat or round terminals. The Circuit Court of Appeals in its opinion says that "this was a novel and useful idea"; but the Court also says: "but invention is not involved in a mere idea." The correct rule is stated by the Court that: "The question always is whether the article devised to carry out the idea involves invention or only ordinary mechanical skill." The Court held the patent void because, while the Court said "No such article is to be found in the prior art," it thought "that the moment the idea was presented no more than ordinary mechanical skill was needed to carry it out." This case merely applies one of the most elementary of the rules of patent law, and it is unnecessary for us to cite numerous and familiar cases applying the rule. It is discussed in *Robinson on Patents*, Vol. 1, beginning at Sec. 87, p. 132, by the author, who reaches the conclusion that "he who merely sees the want" is not an inventor. An extended list of cases relying upon this rule may be had by tracing in the *Citator* the decision of the Supreme Court in *Rubber Top Pencil Co. vs. Howard*, 20 Wall. 498, 22 L. Ed. 410, in which the Supreme Court applied the rule and announced that an idea of itself is not patentable and that to constitute a patentable invention more than mechanical skill must have

been required to devise a means of employing the idea.

Appellant predicates its entire case upon the erroneous assumption that the Wallace patent covers the mere partial blending of the upper thin layer to the under-layer. At p. 104 of our opening brief, we quote from numerous prior patents describing a zone of blending between an upper and an under-layer. For example, Warren Patent 675,430 (R. 499-F) states: This layer is a binding or surfacing layer, and it is constituted to unite with the rough surface of its supporting-layer by entering the spaces, channels, and voids between the stones thereof to a very considerable extent and so as to fill them," and that such upper layer is united with the under-layer by "permeation" so that the under-surface of the upper layer "knits" with the under-layer. Appellant makes no attempt to reconcile its claim that such so-called "blending" was an original idea of Wallace with these prior disclosures. At p. 43 of our opening brief, we pointed out that upon the application for the Wallace patent, the Patent Office ruled that such "blending" was not an original idea, but was old in the art. In an amendment filed February 21, 1910, Wallace requested a claim directed to such "blending" (R. 467). This claim was denied by the Patent Office in its ruling of March 15, 1910, on the ground that there was no novelty over the patent to McDonald. The Patent Office said: "If applicant persists in claims 1 and 3 and claims of like character, it is desired that applicant take this

action as final, since an issue has been reached.” (R. 473.) In response to such final ruling of the Patent Office, Wallace cancelled this claim (R. 474). He is, therefore, bound by his acquiescence in the ruling of the Patent Office, and cannot be heard to the contrary. Appellant has at no time made any attempt to reconcile this ruling of the Patent Office with appellant’s position in this case. Such ruling is, of course, an absolute bar to the interpretation of the Wallace patent in the manner sought by appellant. Contrary to this Patent Office ruling, appellant contends that the patent in suit is not limited to a complete blending but covers a mere partial or zone of blending. However, the distinction between claim 2 of the Wallace patent and the aforesaid rejected claim resides in the fact that claim 2 states that the materials are blended “at the top of the mass,” whereby one compact layer “densest at the top” is formed. With some reservation, appellant suggests that “at the top of the mass” may mean “at the top of the mass of the coarse mixture” (Appellant’s Reply Brief, p. 25). We appreciate appellant’s hesitancy in offering such a suggestion, because it is clearly contrary to Wallace’s understanding as demonstrated by his statements made to the Patent Office. In the Patent Office, on February 5, 1910, Wallace states: “the upper portion of the mass, i. e., the part of the surface subjected to the abrasive action of the traffic” (R. 463). Appellant urges that to give effect to the limitations of claim 2 of the Wallace patent would be to exclude the pavement shown in the patent

drawing. At p. 33 of our opening brief we pointed out that the specification of the Wallace patent qualifies the drawing by stating that while two courses B and C are described, "the completed pavement is not a multi-layer pavement." Furthermore, this drawing was filed with the original application as a foundation for the broad claims made by Wallace but denied by the Patent Office. The Patent Office refused to allow a patent of the scope contemplated by Wallace when he made and filed this drawing, and the Wallace patent must be construed and limited to the part finally granted by the Patent Office as specified in the allowed claims.

Appellant persists in assuming that there is a partial blending of the top layer to the under-layer in Type A. Appellees' physical specimens of Type A (Exhibits "E" and "F") have been presented and identified by Mr. Jensen, the Fresno County Engineer, and Mr. Leyden, the Chief Inspector of the Fresno County Highway System, as fair specimens characteristically representing Type A pavement. Appellant does not even attempt to show that there is any blending of the top course to the under-layer in these specimens, nor does appellant refer to the photograph (Defendants' Exhibit "G") appearing opposite p. 63 of our opening brief, which Mr. Jensen testifies "illustrates that in Type A pavement there is no blending of the binder and finishing courses." Unable to deny that our specimens are established as fair and true examples of Type A pavement, appellant avoids the same altogether and involves itself in a comparison of cer-

tain specimens of Type B and Type A produced by appellant. As shown at p. 134 of our opening brief, the specimens of Type A produced by appellant do not comply with the specifications for Type A and are not fair samples thereof. The Trial Judge observed the witnesses, inspected the pavement, and ruled that Type A is not blended: "I am persuaded from a consideration of all of the facts involved, including an inspection of the pavement produced by the defendants, that the two courses of the pavement produced by them were and are not blended within the meaning of that term as used in plaintiff's patent." (R. 503). The ruling of the District Court on the issue of fact is conclusive.

Blettner vs. Gill, 251 Fed. 81, 82, C. C. A. 7th
 Diamond Patent Co. vs. Webster Bros., 249
 Fed. 155, at 158, C. C. A. 9th.

Appellees have established in this case by the uncontradicted testimony of Mr. Jensen and a comparison of appellant's own exhibits, that the juncture-line between the upper layer and under-layer in Type A pavement is no more irregular than is the juncture-line in all pavements employing large stone pieces (Appellees' Opening Brief, p. 100). Unable to deny the comparison, appellant directs attention to the under-side of Defendants' Exhibit "F" as showing that the base has been cleanly broken away and asserts that therefore there was "a perfectly defined line of cleavage between it and the pavement proper," although appellant knows that to obtain the exhibits for this case it was neces-

sary to cover the base before the wearing surface was applied thereto, in order to remove the wearing surface free of the base. At the oral argument before this Court, counsel for appellees stated that in the taking of specimens the base was covered before the wearing surface was applied, and as evidence in support of that statement, called attention to the testimony of appellant's witness Burdge that in order to obtain specimens free from the base appellant covered the base with paper before the wearing surface was spread (R. 365). While there is no evidence particularly applying to Exhibit "F," the necessity for the covering of the base to obtain samples may be readily assumed from the admitted resort of appellant to that practice. Nor is the under-side of Exhibit "F" a true representation of the irregular line of juncture, because the under-side has been chipped by the chisel employed (Appellant's Reply Brief, p. 11). The true character of the irregular line of cleavage between the base and binder course in Type A pavement is shown by the specimen constituting Appellees' Exhibit "E" herein, for that specimen *includes* a portion of the base, thereby maintaining the irregular juncture-line *intact* for inspection. (R. 180, 181.) We also call the Court's attention to the under-side of the specimen of Type A illustrated in the photograph constituting Defendants' Exhibit "G" and appearing opposite page 63 of our opening brief.

The only proper method of establishing infringement is to compare the alleged infringing thing

with the patent in suit. Appellant has persistently avoided such comparison and has substituted a comparison of Type A with Type B. A comparison of Type A with Type B in lieu of the patent in suit, necessitates the determination of two issues of infringement, because, before the comparison can be relevant, not only must identity be established between Type A and Type B, but also between Type B and the patent in suit. We have heretofore shown the lack of identity between the patent in suit and Type B. As to the identity between Type A and Type B, appellant states "there is no material difference." (Appellant's Reply Brief, p. 8.) This statement is entirely unwarranted and contrary to the uncontradicted oral and documentary evidence in the case. The uncontradicted testimony of Mr. Leyden and Mr. Jensen is that Type A has a top layer of fine material one-quarter inch in thickness, free from any of the stony pieces of the under-layer. (This is required by Type A specifications—R. 35.) In Type B, the fine mixture is in fact pressed or merged completely into the under-mixture so that the stone pieces of the under-mixture protrude at the top of the completed pavement (see our Opening Brief, p. 54). This controlling difference between the two pavements is illustrated in the specimens constituting Appellees' (physical) Exhibits "A," "B," "E" and "F." Furthermore, the specifications of the Type B call for the use of approximately ten per cent more fine material for the top mixture than do the specifications for Type

A.* This ten per cent excess of fine mixture in Type B (which is blended into the under-layer with all of the fine mixture) has no counterpart in Type A. Appellant concedes that Type A differs from Type B in that the under-layer of Type A was individually rolled before application of the top layer, but refers to such rolling as a “colorable, trivial rolling” (Appellant’s Reply Brief, p. 5). There is no justification whatsoever for appellant’s reference to the individual rolling of the under-layer in Type A, as either “colorable” or “trivial.” The twelve-ton roller employed is the largest roller ordinarily used in paving construction (R. 372). The operation of this roller for approximately 15 minutes (conceded in Appellant’s Opening Brief, p. 30), must be recognized as a very substantial and thorough rolling.

The attempt of appellant (beginning at p. 28 of its reply brief) to answer our argument that Type A is not “densest at the top” is characterized as carefully avoiding any reference to the quotations and references appearing at pp. 88–89 of our opening brief. Appellant does not deny that in Wallace Patent 1,183,507, applied for during the pendency of the application for the patent in suit, Wallace used the term “dense” with reference to the filling of voids. Appellant does not accept the invi-

*The Type A specifications call for 1,000 pounds of fine mixture to cover 400 square feet of surface (22½ pounds per square yard—R. 36), whereas the Type B specifications call for 25 pounds of fine mixture per square yard of surface (R. 42).

tation extended at p. 96 of our opening brief, to explain how it can construe the term "dense" in the two Wallace patents to have diametrically opposite meanings.

In appellant's opening brief the claim was made that no one prior to Wallace had ever applied a surface layer while the under-layer was hot (p. 42). In our opening brief we pointed out that there was no such suggestion in the Wallace patent (p. 115), but that more than seven years before Wallace applied for his patent, the advantage and purpose of applying a fine finishing mixture to a hot under-layer was fully set forth and considered by the United States Supreme Court in *U. S. Rubber & Guaranty Co. vs. Assyrian Asphalt Co.*, 183 U. S. 591, 46 L. Ed. 342. As the application of the fine finishing mixture to a hot under-layer is not suggested in the Wallace patent, it is, therefore, of no importance in this case, except that in appellant's opening brief the contention was made that, unless appellees had desired a blending, appellees would not have applied their top course to a hot under-layer. This contention of appellant is not supported in any manner by any testimony or evidence in the case. It is absolutely contradicted by the testimony of Mr. Jensen, who prepared the specifications for Type A pavement (R. 176, 177). The primary value of the decision of the Supreme Court in *U. S. Rubber & Guaranty Co. vs. Assyrian Asphalt Co.*, *supra*, is the authoritative statement therein that the result obtained by applying a fine surface-layer to a hot under-layer is the procuring

of a soldering of the top layer to the under-layer, as distinguished from a blending of a top layer into the under-layer. The purpose of applying the thin surface layer to a hot under-layer is stated in "Asphalt, Its Origin, Its Preparation, and Its Application," by Leo Malo, quoted in the decision of the Supreme Court (*supra*) to be "*to obtain a perfect soldering.*" In its reply brief, appellant asserts that there is no evidence that that was the purpose of appellees in having the under-layer hot in Type A. On the other hand, there is no evidence that appellees' purpose was to obtain a blend, and, in fact, the evidence of Mr. Jensen and Mr. Leyden is that no blend was wanted or obtained.

"The composition of the binder course and the composition of the finishing course remain intact and are not mixed or blended."

(Jensen, Fresno County Engineer—R. 181)

"There is, in fact, no blending of said courses."

(Leyden, Chief Inspector of the Fresno County Highway System—R. 145).

The contention of appellant was not based upon evidence, but was built up solely upon the unwarranted and unsupported claim that there could be no other reason for having the under-layer hot. Now, the decision of the Supreme Court conclusively establishes that the reason for having an under-layer hot at the application of the top layer is not to obtain a blend, but is to obtain a soldering, and that the paving industry was well aware of this

for many years prior to Wallace's alleged invention.

Beginning at page 32 of its reply brief, appellant urges that this Court should refuse to consider the decision of the Supreme Court (*supra*) "in any way." Appellant argues that a defendant is required to set forth in his answer "the prior art which he is to offer in evidence as anticipation" (p. 32). This rule has no application to this case, because the decision of the Supreme Court is not relied upon as an anticipation, but is relied upon to aid the Court in the construction of the patent in suit. It is well settled that no pleading is required of matters of prior art which are relied upon to show what was old and in general use prior to the alleged invention,—not as an anticipation but to distinguish what is old from what is new and enable the Court to place a proper interpretation upon the patent in suit.

"Proof of the state of the art is admissible in equity cases, without any averment in the answer touching the subject and, in actions at law, without giving the notice required when evidence is offered to invalidate the patent. It consists of proof of what was old and in general use at the time of the alleged invention; and may be admitted to show what was then old, or to distinguish what is new, or to aid the Court in the construction of the patent."

Dunbar vs. Meyers, 94 U. S. 187, at 198.)

It was certainly unnecessary for appellees to offer any proof before the trial court of the publi-

cation or authenticity of the decision of the Supreme Court, and it is likewise as unnecessary before this Court. The Court will, of course, take judicial notice of the decisions of the Supreme Court. It is never necessary to either plead or prove a matter of which a Court takes judicial notice.

“Notice and proof were, therefore, unnecessary. The statute requiring notice was not intended to apply to such cases. The Court can take judicial notice of it and give it the same effect as if it had been set up as a defense in the answer and the proof were plenary.”

(Brown vs. Piper, 91 U. S. 37, at p. 43.)

At p. 35 of its reply brief, appellant asserts that the heating of the under-layer described in the opinion of the Supreme Court in *U. S. Rubber & Guaranty Co. vs. Assyrian Asphalt Co.*, *supra*, did not render it “plastic,” and that a permanent adherence of the upper layer did not result. These unfounded assertions of appellant are contrary to the decisions of the various Federal Courts considering the Perkins and Crochet patents, quoted and cited at pp. 108–113 of our opening brief. The effort of appellant at p. 35 of its reply brief, to distinguish between the Perkins and Crochet pavements and the Wallace pavement, produces no distinction except a difference in the materials employed in the under-layer. Admittedly, Wallace did not invent any of the materials employed in Type A, nor did Wallace invent the combination of the thin upper layer of fine material superposed upon

the body of coarse material. Since it was known that a perfect soldering could be accomplished by having the under-layer hot when the upper layer was applied, why could that principle not be employed by appellees? The mere use of such a principle, even if it be in a pavement employing different materials, is within the right of everyone. That is the precise ground of the decision of the Supreme Court in *U. S. Rubber & Guaranty Co. vs. Assyrian Asphalt Co.*, *supra*, in which it is said: "Before the time of either patent the world knew that heat disintegrated some things and melted others, and we cannot concede invention to the thought that that might be true of different kinds of asphalt." In other words, the Supreme Court recognized that, as the principle and result were known, no invention could be claimed in the application of that principle to any particular asphalt mixture. Appellant's reply brief admits that in so far as the decision of the Supreme Court sets forth principles of law, appellees "are, of course, entitled to quote from and rely upon them" (p. 34). We have just stated the principle of law authoritatively announced by the Supreme Court in the case in question. All that appellees need to do to justify the fact that their under-layer was hot at the application of the upper layer, is to rely upon that principle of law.

The reply brief of appellant is permeated with a plea for special consideration for the patent in suit because of the alleged laying of some eighteen million square yards of Type B pavement—some sixty

miles of which was laid in Fresno County. Appellant represents that such pavement was laid under its license. Type B pavement is not that of the patent in suit, and at least as to the sixty miles last mentioned has been condemned as defective by Fresno County (R. 162). There is no evidence that any license has been granted or accepted under the patent in suit, and as far as the county of Fresno is concerned, we know that no royalty has ever been paid under the Wallace patent. The sixty miles of Type B pavement was constructed by Fresno County shortly prior to the expiration of Warren Patent 727,505, and as Type B employed the mixture covered by that patent, royalty was properly paid by Fresno County,—*not under the Wallace patent but under the Warren patent.* Mr. Jensen testifies that the royalty was paid under the Warren patent, and that “since the expiration on May 5, 1920, of that patent, Fresno County has not paid or agreed to pay any further royalty to plaintiff (R. 170). There is no evidence that anybody else has ever paid any royalty under the patent in suit. Appellant states that everyone has heretofore considered Type B to be the patented construction (p. 2). There is no evidence of who is included within the term “everyone,” and we know of no one, except appellant, who is in that frame of mind. There has never been any decision of any Court to that effect, and this Court should be very reluctant to accord the Wallace patent an expanded construction, particularly in view of the tremendous public interest

involved. The only copy of any license which is of record in this case is that constituting the exhibit to the bill of complaint herein. The Wallace patent in suit is not mentioned, and that license refers to "certain patents" (R. 21). We do not know what those patents are; but they obviously are not limited to the single patent here in suit,—if the latter is included at all. We are convinced that the Wallace patent is a mere paper proposition, which for ten years remained unheard of until it was resurrected by appellant shortly prior to the expiration of Warren Patent 727,505. At the oral argument of this case before this Court, counsel for appellant admitted that no pavement had ever been laid employing the "crusher-run" prescribed by the specification and drawing of the patent in suit. Under this admission, the patent is to be construed in accordance with the decision of this Court in *Henry vs. City of Los Angeles*, 255 Fed. 769:

"It is also to be considered that there never has been a water wheel governor constructed in accord with the drawings and specifications of the patent in suit—that is, a governor constructed and using all the principles of governing revealed in the patent. The Court of Appeals of the Sixth Circuit in *National Malleable Casting Co. vs. Buckeye M. I. & C. Co.*, 171 Fed. 847, 96 C. C. A. 515, said:

" 'The use we make of the fact that the device has never gone into actual service is in the construction or interpretation of the patent.

We are justified, in view of the facts of this case, in exercising much caution in attributing to this patent anything more than is plainly shown and distinctly claimed. * * * This inference from nonuse, under the circumstances, is the converse of the inference drawn with respect of a doubtful patent when a showing is made that it has gone into large use and has displaced other devices. It is an inference against utility from the fact of long non-use, unexplained by want of means or opportunity.' ”

It is our earnest contention that Wallace has never contributed anything of value to the paving industry. Appellees' Type A pavement in fact embodies nothing which was original with Wallace. It employs the Warren mixture of expired Warren Patent 727,505, and the public should be protected in its right to employ that mixture, now that the term of appellant's monopoly has ended. Appellant demands an oppressive monopoly under the Wallace patent, when in fact Wallace has taught the paving industry of this country nothing.

Respectfully submitted,

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